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UNITED STATES PATENT AND TRADEMARK OFFICE

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09/430,124	10/29/1999	YOSHIYUKI NAKAMURA	SON-1680	6811

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EXAMINER
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ART UNIT	PAPER NUMBER
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Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 12

Application Number: 09/430,124
Filing Date: October 29, 1999
Appellant(s): NAKAMURA ET AL.

Ronald P. Kananen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 7/7/03 paper no 12.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief (Sony Corporation).

(2)   Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3)   Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4)   Status of Amendments After Final

The statement of the status of the claims contained in the brief is correct.

(5)   Summary of Invention

The summary of invention contained in the brief is deficient because the summary of invention does not refer to page and line numbers from the specification.

(6)   Issues

The appellant's statement of the issues in the brief is correct.

(7)   Grouping of Claims

Appellant's brief includes a statement that group I, claims 4 – 5 and group II, claims 6 - 7 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8)   Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   Prior Art of Record

6,347,342 B1	Marcos et al.	02-2002
6,049,819	Bulkle et al.	04-2000
6,052,711 B1	Gish	04-2000
6,405,266	Bass et al.	06-2002
6,453,356	Sheard et al.	09-2002

(10)   Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 4 – 7 are rejected under 35 U.S.C. 102(e) as being unpatentable by Marcos, US

patent no. 6,347,342. This rejection is set forth in prior Office Action, Paper No. 9.

As to claim 4, Marcos teaches a mediating system (mediating component 204 of

fig. 2, col. 6 line 20 to col. 7, line 54), "n" application systems (202, 206 of fig. 2), one

data entry (message directed to the server via mediating component 204, col. 7 lines 15

- 20) "n" data exits (mediating component performs mapping and translating, col. 7 lines

16 - 19), a transmission function group (mapping and translating, col. 7 lines 16 - 19)

one of said "n" application system (202 or 206 of fig. 2) destination application system

(202 or 206 of fig. 2), a transmission path determination function group (mediating

component 204 forwards the translated information, col. 7 lines 19 - 22) destination

name (reference, col. 7 lines 30 – 40).

Marco's sytem is on the network client-server environment (client-server, col. 1 -

7, a server would connect to a plurality of clients.

As to claim 5, Marco teaches database (database used for querying, col. 7 lines

28 – 31), adapter (APIs, col. 2 lines 20 - 25).

As to claim 6, see claim 4 above for rejection. Claim 4 also meets the

limitations a plurality of data exits (mediating component performs mapping and

translating to applications 202 and 206, col. 7 lines 16 - 19), first application system

(202 of fig. 2) second application (206 of fig. 2).

As to claim 7, see claim 5 above.

(11)   *Response to Argument*

Appellant argued that

Argument I: in the prior art of record, the mediating system can reside on either

the client or the server or in a single process machine, and the claimed mediating

system is not included within any of the application systems.

Argument II: mediating system includes one data entry and a plurality or "n" data

exits.

In response to argument I, applicant argued that the references fail to show

certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., mediating system is **not included** within any of the application

systems) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further more, Appellant is reminded that the transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

Actually, what is claimed is the "mediating system is centrally located **among** "n" application systems". The phrase "not included" as argued does not have the same meaning as "among" which is claimed. As to the Webster's Dictionary, "among" means "in or through". Marcos teaches the use of the "mediating system centrally located among "n" application systems" (Mediating component 204 can reside on either the client or the server or in a single-process machine, col. 7 lines 44 – 46).

Further more, even if the examiner were to consider "not included", the examiner believes this limitation is also taught by Marcos (Mediating component 204 can reside in a single-process machine (i.e., independent of the server or client), col. 7 lines 44 – 46).

Therefore, Marcos anticipates the claimed limitations.

In response to argument II, the reference the examiner provided teaches one data entry (the mediating component 204 has one data entry to direct the message, col. 7 lines 15 - 20), and a plurality of data exits (on the network environment, when a client requests a server object, the mediating system has to connect to a plurality of servers to query for the requested server object, col. 7 lines 24 – 30).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

September 20, 2003
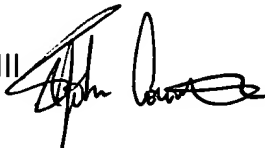
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